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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/645,284	08/21/2003	Jimmy A. Parks	2370.ACTI.NP	7245
27472	7590	08/09/2006	EXAMINER CHAMBERS, TROY	
RANDALL B. BATEMAN BATEMAN IP LAW GROUP 8 EAST BROADWAY, SUITE 550 PO BOX 1319 SALT LAKE CITY, UT 84110			ART UNIT 3641	
DATE MAILED: 08/09/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/645,284	PARKS ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Troy Chambers	3641	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 4,6 and 18-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 7-17 and 22-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. ____   |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>3/10/05</u>   | 6) <input type="checkbox"/> Other: ____                                     |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. This application contains claims 18-21 drawn to an invention nonelected with traverse. A complete reply to the final rejection must include cancellation of nonelected claims 18-21 or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

### ***Drawings***

2. Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the chamber that is capable of stopping and containing a bullet (claims 1, 7, 13 and 24) "plurality of outlets for releasing projectiles from the at least one bullet stop" (claim 24) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate

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prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-3, 5, 7-17 and 22-30 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, neither the original written specification nor the drawings (applicant's elected Figure 3) provide adequate support for a chamber that is capable of stopping or containing a bullet. Applicant's

elected figure 3 shows a chamber in which a bullet enters and then falls into a screw transport mechanism for removal. The specification never describes the bullet as stopping or being contained. In this instant, to stop should be interpreted as "ceasing all movement" and to contain should be interpreted as "keeping within limits". The applicant specification does not describe any of these features as they relate to the chamber.

6. Claims 1-3, 5, 7-17 and 22-30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. As discussed above, the specification fails to provide a written description for a chamber that is capable of stopping and containing a bullet. Needless to say, the specification also fails to describe how or in what manner these features are achieved.

7. Claims 24-29 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 24 requires "a plurality of outlets for releasing projectiles from the at least one bullet stop and containment chamber". However, it is clear that for each bullet stop and containment chamber, there is only one outlet. Applicant should consider amending the claim to recite "at least one outlet".

8. Claim 26 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, claim 26 requires a "plurality of outlets comprising a plurality of funnels." Neither the written specification nor drawings disclose such a feature.

9. Claim 28 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 28 recites a transport mechanism that comprises a vacuum. Claim 24, from which claim 28 depend, describes the transport mechanism as a screw and for which a plurality of projectiles are released to. Neither the specification nor the drawings describe the vacuum system as being part of the transport mechanism (i.e., capable of transporting projectiles). This also results in a violation of the written description requirement under 35 USC 112, first paragraph.

10. The current claims contain extensive violations of 35 USC 112, first paragraph. In view of this, the Examiner will apply prior art as best can be applied in view of said violations.

***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

12. Claims 1, 2, 3, 5, 13, 22, 24, 25 AND 29 are rejected under 35 U.S.C. 102(a) as being anticipated by applicant's prior art Fig. 1 and the admission in paragraphs [0032-0044].

***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 1, 5, 11, 12, 13, 14, 17 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. 5535662 issued to Bateman in view of US 2003/0177895 issued to Lambert.

15. With respect to claims 1, 11, 12, 13, 14, 17 and 23, Bateman discloses a projectile retrieval system 10, comprising a plurality (col. 7, ll. 38-40) projectile deceleration areas 16; and, a transport mechanism comprising an airtight (col. 7, ll. 8-21) housing 54 including a vacuum system 60, 62, 64. However, Bateman does not disclose a transport mechanism including a screw and the details thereof.

With respect to claims 1, 5 and 13 Lambert discloses a transport mechanism disposed in communication with a projectile deceleration area comprising an elongate screw 244 configured to carry projectiles from the deceleration area to a remote location [0090]. With respect to claim 5, screws inherently possess a central axis and have a thread (fin) that extends helically for the length of the screw in a first direction.

At the time of the invention, one of ordinary skill in the art would have found it obvious to provide the transport housing 54 of Bateman with the transport screw of Lambert. The suggestion/motivation for doing so would have been to allow the bullets to be removed by a means other than manually (Lambert, [0090]).

16. Claims 7, 8, 9, 10, 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bateman and Lambert as applied to claims 1 and 13 above, and further in view of U.S. 6311980 issued to Sovine. Bateman and Lambert disclose a combined projectile retrieval system as described above. However, neither Bateman nor Lambert discloses a valving system (claims 7-10) or a control member (claims 15, 16) as claimed by the applicant.

Sovine discloses such a valving system/control member. Specifically, Sovine discloses a bullet retrieval system 100, comprising at least one valve 114 having a first closed position and a second open position (col. 6, ll. 1-10) and a remote control valve actuator 128 (col. 6, ll. 50-58) operated by computer (col. 7, ll. 28-30) or by an automatic detection sensor (col. 7, ll. 59-67). The valve 114 (or control member) acts to prevent the bullets from entering the transport mechanism until prompted to do so (col. 6, ll. 3-7)



At the time of the invention, one of ordinary skill in the art would have found it obvious to provide the combined invention of Bateman and Lambert with the automated valving system of Sovine. The suggestion/motivation for doing so would have been to allow an operator to selectively empty an one of the projectile deceleration areas 16 of Bateman (Sovine, col. 3, ll. 39-43).

***Response to Arguments***

17. Applicant's arguments filed 05/05/06 have been fully considered but they are not persuasive.

18. With respect to the use of the Lambert reference, 35 USC 103(c) provides, in part:

(c)

(1) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, *at the time the claimed invention was made*, owned by the same person or subject to an obligation of assignment to the same person.

(Emphasis added).

19. The claimed invention was constructively made at the filing of the provisional application on 09/17/02. At this time, there appears to be no assignment associated with the filing of the provisional application. Assignments can be filed for provisional applications. Therefore, *at the time the invention was made* the instant application was not owned by or subject to assignment to ACTION TARGET, INC.

***Conclusion***

20. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

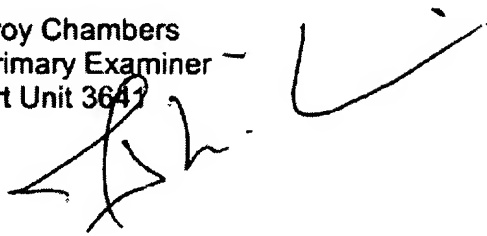
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Troy Chambers whose telephone number is (571) 272-6874 between the hours of 7:00 a.m. to 3:30 p.m., M-F. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael J. Carone, can be reached at (571) 272-6873.

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Troy Chambers  
Primary Examiner  
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A handwritten signature in black ink, appearing to be 'Troy Chambers', written over the printed name and title.

TC  
27 July 2006